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10/787,399	02/26/2004	Dustin Sorenson	DC-05334	4527
33438 7590 07/07/2009 HAMILTON & TERRILE, LLP P.O. BOX 203518 AUSTIN, TX 78720				
EXAMINER RILEY, MARCUS T				
ART UNIT 2625		PAPER NUMBER		
NOTIFICATION DATE 07/07/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

tmunoz@hamiltontertile.com

### Office Action Summary

**Application No.**

10/787,399

**Applicant(s)**

SORENSEN ET AL.

**Examiner**

MARCUS T. RILEY

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02/26/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CIS-100)
- Paper No(s)/Mail Date 05/27/2004.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. In view of the Appeal Brief filed on July 24, 2008, PROSECUTION IS HEREBY REOPENED. New grounds of rejections set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

\*\*\*.

**Response to Arguments**

2. Applicant's arguments with respect to claim1-20 have been considered but are moot in view of the new ground(s) of rejection.

**Claim Objections**

*(The previous claim objections are withdrawn in light of the applicant's amendments.)*

**Claim Rejections - 35 USC § 102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1, 3-10 & 13-19** are rejected under 35 U.S.C. 102(b) as being anticipated by Haines et al. (US 2002/0073148 A1 hereinafter, Haines '801).

**Regarding claim 1;** Haines '148 discloses a system for managing orders through a network of consumables for an information handling system peripheral, the system comprising

(See Figure 1 wherein Fig. 1 shows a self-adjusting consumable order-assistance system):

consumable handler associated with the information handling system (See Figure 1, where #12 is the personal computer associated with the self-adjusting consumable order-assistance system );

the consumable handler operable to monitor the peripheral to detect a consumable trigger event (See Figure 2, where #12 interacts with peripheral device 14 to obtain information on consumable levels. e.g. #12 receives information like media levels and types, warnings and/or notifications, job assurance, printer capabilities and impending

maintenance notification. See Paragraph 0046);

and to assemble order information associated with the consumable trigger event in a predetermined format (Several techniques are available for notifying a maintainer of a need for maintenance, consumable replenishment and repair...e.g. an email is generated from each individual printer whenever the printer needs attention, maintenance or replenishment... e.g., a "toner low" condition could trigger a consolidated email. See paragraphs 0040-0041);

an order engine operable (See Figure 1 wherein #30 is the Order Engine) to present and accept an order form for the consumable through the network and at the information handling system (*"...program 30 can be further configured to provide an electronic shopping cart in order to enable electronic ordering of a consumable from PC 12 via communication link 18..."* See paragraph 0028);

and a pre-population engine (#38 is the Electronic Shopping Cart Data List that is pre-populated. See Paragraph 0022) interfaced with the consumable handler through the network and with the order engine (See Figure 1 wherein #30 is the Order engine, #12 is the consumer handler and #38 is the pre-population engine coupled together via bus 15. See Paragraph 0019 & 0038)

the pre-population engine operable to complete the order form for presentation to the information handling system in response to the order information (*"Data list 38 formats data that is needed to fill in shopping cart 138, such as order information identifying a consumable and order location information for the consumable."* paragraphs 0022-0023).

**Regarding claim 3;** Haines '148 discloses where the peripheral comprises a laser printer (*"...computer peripheral device 14 comprises a printer 16, such as a laser printer."* See paragraph 0020)

and the consumable comprises one or more of toner, imaging drum or imaging drum belt (*"e.g. the user is notified during the print job that the printer is running low of toner."* See paragraphs 0036).

**Regarding claim 4;** Haines '148 discloses where the consumable handler comprises a

module (See Figure 3, Service Provider 150) ;

operable to interface with an accounting application and plural peripherals (See Figure 3, where the Service Provider 150 interacts with #152 for job accounting and the plural peripherals #'s 14, 114 & 214);

the module tracking an inventory of consumables to place aggregate orders for consumables to supply the plural peripherals (The Service Provider 150 keeps track of the inventory such as alternative parts and what and when to replace of the plural peripherals 14, 114 & 214 . See paragraphs 0048-0051).

**Regarding claim 5;** Haines '148 discloses where the consumable handler module is further operable to automatically adjust the consumable inventory by decrementing the consumable supply at each consumable trigger event (See Figure 3 wherein Fig. 3 shows the Service Provider 150 that automatically keeps track of the inventory such as alternative parts, what and when to replace, also provides job accounting information and bill back information. See paragraphs 0048-0051).

**Regarding claim 6;** Haines '148 discloses an information handling system database associated with the pre-population engine and having a unique identifier (See Figure 1 wherein Fig. 1 wherein #38 is the Electronic Shopping Cart Data List that is pre-populated. *"Data list 38 formats data that is needed to fill in shopping cart 138, such as order information identifying a consumable and order location information for the consumable."* paragraphs 0022-0023);

for each of plural information handling systems with payment and delivery information wherein the pre-population engine is further operable to complete the order form by populating the payment and delivery information of a unique identifier included with the order information (The electronic shopping cart enables a customer to select merchandise, review selected items, make modifications or additions to an order, and purchase merchandise for delivery." See paragraphs 0022-0023).

**Regarding claim 7;** Haines '148 discloses where the order engine is further operable to accept updates to the order form entered at the information handling system (The electronic shopping cart enables a customer make modifications or additions to an order, and purchase merchandise. See paragraphs 0022-0023).

**Regarding claim 8;** Haines '148 discloses where the order information comprises printer identification information (e.g., a printer model, serial number; See paragraphs 0049)

and wherein the pre-population engine is further operable to complete the order form with a consumable associated with the printer (See Figures 3 wherein Fig. 3 shows where an individual then submits a completed external order 155 to a reseller; #114 is a printer. See Paragraph 0049)

**Regarding claim 9;** Haines '148 discloses where the trigger event comprises one or more of consumable quantity, consumable consumption rate, time period between consumable orders, consumable usage patterns, consumable average daily use, or a user-selected parameter (See Figure 3 wherein the service provider is triggered to show time period between consumable orders as illustrated by the "when to replace" designation.)

**Regarding claim 10;** Haines '148 discloses a method for managing orders through a network of consumables for an information handling system printer, the method comprising (See Figure 1 wherein fig 1 shows a self-adjusting consumable order-assistance system with a printer driver #25):

detecting a consumable trigger event associated with the peripheral (e.g., a "toner low" condition could trigger a consolidated email; See paragraphs 0026, 0036 & 0040-0041);

assembling order information associated with the consumable trigger event in a predetermined format (Several techniques are available for notifying a maintainer of a need for maintenance, consumable replenishment and repair...e.g. an email is generated from each individual printer whenever the printer needs attention, maintenance or replenishment... e.g., a "toner low" condition could trigger a consolidated email. See paragraphs 0040-0041);

communicating the order information through the network to a consumable order server (“... embedded web server 41 provides an interface by cooperating with workgroup administrator interface 210 (see FIG. 1) to the order-assistance system 10 (of FIG. 1).” See paragraph 0037);

pre-populating an order form at the consumable order server in accordance with the order information (“Data list 38 formats data that is needed to fill in shopping cart 138, such as order information identifying a consumable and order location information for the consumable.” See paragraph 0022-0023).

presenting the order form through the network and at the information handling system and accepting a confirmation of the order form at the information handling system (The user interaction site is configured to receive a notification from the computer peripheral device via the messaging system of a need to order a consumable...” paragraphs 0007-0009 & 0026);

and delivering the consumable in accordance with the order form (Data list 38 formats data that is needed to fill in shopping cart 138, such as order information identifying a consumable and order location information for the consumable.” See 0022-0023).

**Regarding claim 13;** Claim 13 contains substantially the same subject matter as claim 3. Therefore, claim 13 is rejected on the same grounds as claim 3.

**Regarding claim 14 & 15;** Claims 14 & 15 contains substantially the same subject matter as claim 6. Therefore, claims 14 & 15 are rejected on the same grounds as claim 6.

**Regarding claim 16;** Claim 16 contains substantially the same subject matter as claim 9. Therefore, claim 16 is rejected on the same grounds as claim 9.

**Regarding claim 17;** Claim 17 contains substantially the same subject matter as claim 4. Therefore, claim 17 is rejected on the same grounds as claim 4.



**Regarding claim 18;** Haines '148 discloses an information handling system comprising

(See Figure 1 wherein fig 1 shows a self-adjusting consumable order-assistance system):

plural components operable to process information for printing by a printer onto a medium and a printer interfaced with the plural components to accept and print the information with a consumable (See Figure 1 where computer peripheral device 14 comprises a printer 16 and PC 12 operates to generate a print job for printer 16." See paragraph 0020 & 0032);

an operating system operable to coordinate operation of the plural components ("*Service provider 250 interacts via one or more PCs 12 with database 211. More particularly, service provider 250 comprises a maintainer 251 operating on a PC 12, a consumables buyer 252 also operating on a PC 12, and the management information system (MIS) manager and/or printer buyer 253 utilizing a PC 12.*" page 5, paragraph 0055);

a printer driver (See Figure 1 wherein #25 is the printer driver) associated with the operating system the printer driver operable to coordinate communication of the information to the printer and to detect available consumable quantity (The consumable order-assistance system then prompts the user using the printer driver 25 (see FIG. 1), or the user is notified during the print job that the printer is running low of toner. See paragraph 0037);

to display the trigger event at the information handling system for user-selected initiation of a consumable order and to communicate order information to a consumable order server upon user-selected initiation of a consumable order ( See Figure 1 wherein the Consumable Order Assistance System 10 has a consumable order assistance computer program 30 configured to receive a notification 44 from peripheral device 14 via messaging system 40 of a need to order a particular consumable, alert a user of PC 12 of notification 44, and provide an order location to the user for the consumable. e.g., a "toner low" condition could trigger a consolidated email; (paragraphs 0026, 0036 & 0040-0041));

and a browser interfaced with the consumable handler and the consumable order server, the browser operable to display a consumable order form provided by the consumable order server (The electronic shopping cart enables a customer to browse and select merchandise, review selected items, make modifications or additions to an order, and purchase merchandise." See paragraph 0022-0023).

the consumable order form automatically completed to support user-selected confirmation of a consumable order ("Data list 38 formats data that is needed to fill in shopping cart 138, such as order information identifying a consumable and order location information for the consumable." See paragraph 0022-0023).

**Regarding claim 19;** Haines '148 discloses where the printer comprises a laser printer, the order information comprises a laser printer identifier, and the order form comprises a laser printer toner associated with the laser printer identifier and automatically selected by the order server ("*...computer peripheral device 14 comprises a printer 16, such as a laser printer.*" See paragraph 0020) See also ("*... and wherein the printer runs low of toner. The consumable order-assistance system then prompts the user using the printer driver 25 (see FIG. 1), or the user is notified during the print job that the printer is running low of toner.*" page 3, paragraph 0036).

### **Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 2, 11 & 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Haines et al. (US 2002/0073148 A1 hereinafter, Haines '801) in combination with Castle et al. (US 6,109,723 hereinafter, Castle '723).

**Regarding claim 2;** Haines '148 does not expressly disclose where the peripheral comprises an ink jet printer and the consumable comprises one or more of ink or ink head device.

Castle '723 discloses where the peripheral comprises an ink jet printer and the consumable comprises one or more of ink or ink head device ("*FIG. 1 shows a computer 100 connected to inkjet printer 130. Inkjet printer 130 has a printer memory device 135 which is capable of storing characteristics from peripheral devices such as ink supply cartridge 110 and inkjet printhead 120 of inkjet print cartridge 150.*" column 2, lines 35-39).

Haines '148 and Castle '723 are combinable because they are from same field of endeavor of printer systems ("*This invention relates to printers and, more particularly, to a method and apparatus for determining an optimum print density for an ink jet printer.*" Castle '723 at column 1, lines 6-8).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the network information system as taught by Haines '148 by adding where the peripheral comprises an ink jet printer and the consumable comprises one or more of ink or ink head device as taught by Castle '723. The motivation for doing so would have been because to provide an information system that would be successful at maximizing the speed of the ink jet printers while improving the print quality. Therefore, it would have been obvious to combine Haines '148 with Castle '723 to obtain the invention as specified in claim 1.

**Regarding claim 11;** Claim 11 contains substantially the same subject matter as claim 2. Therefore, claim 11 is rejected on the same grounds as claim 2.

**Regarding claim 20;** Haines '148 discloses wherein the order is automatically selected by the order server (System 10 is configured to automate the order process for consumables for several unique environments. Additionally, the maintenance, or care and feeding, of computer peripheral devices such as printers is automated with system 10. See paragraph 0030).

Haines '148 as modified does not expressly disclose where the printer comprises an ink jet printer, the order information comprises an ink jet printer identifier, and the order form comprises an ink jet cartridge associated with the ink jet printer identifier.

Castle '723 discloses where the printer comprises an ink jet printer, the order information comprises an ink jet printer identifier, and the order form comprises an ink jet cartridge associated with the ink jet printer identifier (*"FIG. 1 shows a computer 100 connected to ink jet printer 130. Ink jet printer 130 has a printer memory device 135 which is capable of storing characteristics from peripheral devices such as ink supply cartridge 110 and ink jet printhead 120 of ink jet print cartridge 150."* column 2, lines 35-39).

Haines '148 and Castle '723 are combinable because they are from same field of endeavor of printer systems (*"This invention relates to printers and, more particularly, to a method and apparatus for determining an optimum print density for an ink jet printer."* Castle '723 at column 1, lines 6-8).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the printer system as taught by Haines '148 by adding where the printer comprises an ink jet printer, the order information comprises an ink jet printer identifier, and the order form comprises an ink jet cartridge associated with the ink jet printer identifier as taught by Castle '723. The motivation for doing so would have been to provide an information system that would be successful at maximizing the speed of the ink jet printers while improving the print quality. Therefore, it would have been obvious to combine Haines '148 with Castle '732 to obtain the invention as specified in claim 18.

7. **Claim 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over Haines et al. (US 2002/0073148 A1 hereinafter, Haines '801) in combination with Spurr et al. (US 6,106,166 hereinafter, Spurr '166).

**Regarding claim 12;** Haines '148 as modified does not expressly disclose where the consumable further comprises photographic printing paper.

Spurr '166 discloses where the consumable further comprises photographic printing paper (See Figure 7 wherein Fig. 7 shows schematically how a high-volume photo-processing apparatus 84 is adapted for sensing consumable photosensitive paper. See column 10, lines 38-41).

Haines '148 and Spurr '166 are combinable because they are from same field of endeavor of printer systems ("*This invention generally relates to printing....*" Spurr '166 at column 1, line 25).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the printer system as taught by Haines '148 by adding where the consumable further comprises photographic printing paper as taught by Spurr '166. The motivation for doing so would have been to assure a quality product for customers use. Therefore, it would have been obvious to combine Haines '148 with Castle '732 to obtain the invention as specified in claim 18.

**Examiner Notes**

8. The Examiner cites particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that,

in preparing responses, the applicant fully considers the references in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or as disclosed by the Examiner.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCUS T. RILEY whose telephone number is (571)270-1581. The examiner can normally be reached on Monday - Friday, 7:30-5:00, est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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